

**ATTENTION: PCT LEGAL OFFICE***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE*

In re application of:	*	Attorney Docket No.: 3695-0101P
SACCO, et al.	*	
	*	
Serial No.: 09/486,660	*	
	*	
Int'l. Application No.: PCT/IT98/00231	*	Art Unit:
	*	
I.A. Filing Date: 08/11/98	*	Examiner:
	*	
Title: TRANSGENIC ANIMALS FOR THE	*	
STUDY OF BIOLOGICAL, PHYSICAL	*	
AND CHEMICAL TOXIC AGENTS	*	

September 28, 2001

**RENEWED REQUEST FOR STATUS UNDER 37 CFR 1.42**  
**AND**  
**RENEWED PETITION UNDER 37 CFR 1.47(A)**

Box: PCT  
Assistant Commissioner for Patents  
Washington, DC 20231

**Attention: PCT Legal Office**

Sir:

This is in response to the April 30, 2001 Decision dismissing without prejudice Applicants' request for status under 37 CFR 1.42 along with their petition under 37 CFR 1.47(a). Reconsideration was originally set to be requested by June 30, 2001. A request for a three-month extension of time under 37 CFR 1.136(a) accompanies this Renewed Request & Petition.

The subject U.S. patent application names six inventors, one of whom – namely, Romeo Roncucci - is deceased. Mr. Roncucci left four heirs: Sylvie Roncucci, Rachele Roncucci, Regine Roncucci, and Roxanne Roncucci. As pointed out in the original Request & Petition, the guardian of one of the heirs of Mr. Roncucci, *i.e.*, Roxanne Roncucci, is Anne Georgette Cristiane Delachet. Applicants have not been able to obtain execution of the appropriate application papers by Ms. Delachet on behalf of Roxanne Roncucci.

Applicants respectfully renew their petition under the provisions of 37 CFR 1.47(a) that the subject U.S. patent application be accepted and processed by the USPTO in order to preserve the rights of the parties and to prevent irreparable damage. The fee set forth in 37 CFR 1.17(i) accompanied the original Petition & Request.

Applicants' response to the April 30, 2001 Decision (dismissal without prejudice) has been delayed in part by issues relating to legal representation of the owners of the application. Once those issues were resolved, steps were promptly taken to respond to the issues raised in the Dismissal.

The discussion of the various issues raised in the Decision, as discussed below, follows the order on pages 2-4 of the Decision:

Sylvie Roncucci. Application papers including a declaration form, identifying each inventor and the country of citizenship of each invention and stating that the person making the declaration believes the named inventors to be the original and first inventors of the subject matter claimed and for which a patent is sought, were forwarded to Sylvie Roncucci on or about September 25, 2001. The executed declaration will be forwarded to the PCT Legal Office as soon as it is received by the undersigned.

Rachele and Regine Roncucci. Application papers including a declaration form, identifying each inventor and the country of citizenship of each invention and stating that the person making the declaration believes the named inventors to be the original and first inventors of the subject matter claimed and for which a patent is sought, were forwarded to Maria Novella Castagnoli, the guardian of Rachele Roncucci and of Regine Roncucci, on or about September 25, 2001. The executed declaration will be forwarded to the PCT Legal Office as soon as it is received by the undersigned.

Roxanne Roncucci. The Decision stated that documentary evidence should be provided, supported by a Declaration by person having firsthand knowledge relevant to the failure to obtain execution of the application papers by Anne Georgette Cristiane Delachet, the guardian of Roxanne Roncucci, including the details of Mr. Bromley's personal trip to attempt to meet with Ms. Delachet in October of 2000. Enclosed herewith is a faxed copy of a letter enclosing a Declaration signed by Dr. Bromley providing the relevant facts and details. The letter also encloses information pertaining to a renewed effort to obtain the signature of Ms. Delachet on the complete application papers. Also enclosed herewith are copies of the exhibits mentioned in Dr. Bromley's Declaration.

In the renewed effort to obtain the signature of Ms. Delachet on the complete application papers, a declaration form, identifying each inventor and the country of citizenship of each invention and stating that the person making the declaration believes the named inventors to be the original and first inventors of the subject matter claimed and for which a patent is sought, was forwarded to Anne Georgette Cristiane Delachet, the guardian of Roxanne Roncucci, on September 25, 2001, along with a copy of the specification, claims, and drawings. DHL delivery report 4754533000 (copy enclosed) indicates that delivery of the complete application papers to Ms.

Delachet was accomplished on September 26, 2001. The executed declaration will be forwarded to the PCT Legal Office when and if it is received by the undersigned. Alternatively, if the executed declaration is not received from Ms. Delachet, the undersigned will forward evidence relevant to the continued impossibility of obtaining Ms. Delachet's execution of the application papers.

Applicants respectfully petition that the present application be accepted for United States national stage processing, if necessary without the signature of the guardian of Roxanne Roncucci, one of the heirs of deceased joint inventor Romeo Roncucci. If the PCT Legal Office believes that sufficient evidentiary material has not yet been made of record to justify acceptance, it is respectfully requested that this matter be held in abeyance until the forthcoming materials detailed above are submitted.

Should the PCT Legal Examiner wish to discuss any aspect of this matter with Applicants' representative, the PCT Legal Examiner is respectfully requested to telephone Richard Gallagher (Reg. No. 28,781) at (703) 205-8008.

If necessary, the Commissioner is hereby authorized in this,

SN 09/486,660  
Renewed Request & Petition

concurrent, and future replies, to charge payment or credit any  
overpayment to Deposit Account No. 02-2448 for any additional fee  
required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time  
fees.

Respectfully submitted,  
BIRCH, STEWART, KOLASCH & BIRCH, LLP

By Rich Lally 28,781  
for Joe McKinney Muncy  
Reg. No. 32,334

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

Enclosed:

Roland letter with Bromley Declaration;  
DHL delivery report 4530975131  
DHL delivery report 4530975116  
Photographs Nice FR 10/20/00  
DHL delivery report 4754533000

**ANDRE ROLAND**  
**Intellectual Property Services**

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P.O. Box 1255  
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**Telefax**

<b>To :</b> Mr. Richard Gallagher <b>Company :</b> Birch, Stewart, Kolasch & Birch, LLP <b>Telefax Nr. :</b> +1.703.205.80.50 <b>Telephone Nr. :</b> +1.703.205.80.00	<b>Number of Pages (1st page included) :</b> 06 Lausanne, September 26, 2001 <input type="checkbox"/> Only by telefax <input checked="" type="checkbox"/> Confirmation by courier (FedEx)
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US Patent Application No. 09/486.660 filed February 28, 2000  
"TRANSGENIC ANIMALS FOR THE STUDY OF BIOLOGICAL PHYSICAL AND CHEMICAL TOXIC AGENTS"  
In the name of Marla Grazia SACCO et al  
Y/Ref.: 3695-0101P  
O/Ref.: 0014-024.B.WO-US

Dear Mr. Gallagher,

Further to your mail dated September 21, 2001, please find enclosed:

- the Declaration signed by Mr. Peter Bromley,
- a copy of the letter sent to Mrs. Delachet by DHL on September 25, 2001 with the enclosures (specification, claims, drawings, and Declaration/Power of Attorney form),
- translation in English of the letter sent to Mrs. Delachet

Mrs. Delachet should be receiving tomorrow (09.27.01) the DHL, we will by then be able to produce the "DHL tracking report" we will forward it to your office at receipt.

The other papers have been sent to the different inventors and heirs, as soon as we receive them signed in return they will be forwarded to your office.

Best regards,

Caroline Aguirre

**THIS TELEFAX MESSAGE IS CONFIDENTIAL AND ONLY FOR THE USE OF THE  
INDIVIDUAL OR COMPANY NAMED ABOVE**

If the reader is not the intended recipient, or the employee or agent responsible to deliver it the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone or fax, so that we may arrange for the return of the original message to us. THANK YOU

## PATENT

*IN THE UNITED STATES PATENT AND TRADEMARK OFFICE*

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SACCO, et al.	*	
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Serial No.: 09/486,660	*	
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Int'l. Application No.: PCT/IT98/00231	*	Art Unit:
	*	
I.A. Filing Date: 08/11/98	*	Examiner:
	*	
Title: TRANSGENIC ANIMALS FOR THE	*	
STUDY OF BIOLOGICAL, PHYSICAL	*	
AND CHEMICAL TOXIC AGENTS	*	

**DECLARATION UNDER 37 CFR 1.132**

Box: PCT  
Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

I, Peter Bromley, declare and say as follows:

I am the Peter Bromley who is one of the co-inventors in the subject U.S. patent application. I am also President & Chief Executive Officer of Gene Control S.A., a corporation of Switzerland, which is an assignee of a partial interest in the subject U.S. patent application.

I have personally attempted to obtain the signature of Ms. Anne Georgette Cristiane Delachet, guardian of Roxanne Roncucci, a minor heir of our deceased co-inventor Romeo Roncucci.



SN 09/486,660  
Bromley Declaration  
Page 2

On October 19<sup>th</sup> and again on October 20<sup>th</sup>, I sent letters to Ms. Delachet by DHL courier service explaining the situation and the need for a rapid signature. The documents to be signed were included in each letter. DHL made attempts to deliver the letter of the 19<sup>th</sup> on October (2000) 20 at 12:40, 23 at 12:34, 24 at 13:30, 24 at 19:21, and 26 at 11:19. DHL made attempts to deliver the letter of the 20<sup>th</sup> on October (2000) 23 at 12:35, 24 at 12:57, and 24 at 19:21. Each time Ms. Delachet was absent from her residence. Enclosed is a copy of a detailed report generated by DHL documenting their repeated failure to deliver the documents to Ms. Delachet.

In addition to my attempts to contact Ms. Delachet by letter as explained above and in my Declaration under 37 CFR 1.132 of October 20, 2000, I traveled to Nice, France and attempted to meet with Ms. Delachet in person on Monday, October 20, 2000. Carrying a copy of the documents for her to sign, I went to her place of residence and rang the doorbell, but received no answer. Enclosed are copies of several photographs taken as witness to my attempt to contact Ms. Delachet in person.

Just recently, on \_\_\_\_\_, I sent a complete copy of the application papers (specification, claims, drawings, and Declaration/Power of Attorney form) to Ms. Delachet at her last known place of address (that is, Avenue Brancolar 111/A, 06100 Nice, France) by DHL courier. Enclosed is a copy of the DHL report indicating that the documents could not be delivered to Ms. Delachet.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed

26. SEP. 2001 9:53

ANDRE ROLAND +4121 3214412

Nº1423 P. 4/6

SN 09/486,660  
Bromley Declaration  
Page 3

to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: 25.09.01

Peter Bromley.  
Peter Bromley

Enclosed:

DHL delivery report 4530975131  
DHL delivery report 4530975116  
Photographs Nice FR 10/20/00  
DHL delivery report \_\_\_\_\_

**Gene Control S.A.**

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**PAR DHL**

Madame Anne Georgette Christiane Delachet  
Chemin de Brancolard, 119/A  
06100 Nice  
France

Genève, le 25 septembre 2001

Concerne : Brevet IP no. MI 97 A001972 et PCT/IT98/00231 – Brevetto n° 129445.

Madame,

Vous n'êtes pas sans savoir que les droits des brevets mentionnés doivent être maintenus aux USA et au Canada, et que pour cette raison l'ensemble des inventeurs, respectivement des héritiers des inventeurs doivent donner leur accord à cette opération en signant les papiers officiels de renouvellement.

Nous vous informons que Gene Control SA compte parmi ses fondateurs Peter Bromley (qui avait à l'époque lancé ce projet avec Mr Roméo Roncucci), que nous sommes depuis 1998 propriétaire de 40 % des brevets susmentionnés (le restant étant pour l'instant propriété du Centre National de la Recherche italien (CNR) et l'Union Européenne(UE)) et que, ayant souffert de la gestion du CNR de cette affaire, nous avons dès aujourd'hui repris la gestion de ces brevets et sommes en négociation avec le CNR et l'UE concernant l'acquisition de la totalité des droits de propriété de ce brevet.

Nous avons appris par le CNR, qui *gérât* le brevet, que vous aviez renvoyé ces documents non signés au CNR. Eu égard à ce qui précède, nous vous prions de bien vouloir apposer votre signature sur le formulaire ad hoc joint à cette lettre afin de valider le renouvellement du brevet, comme l'ont déjà fait toutes les autres personnes intéressées.

Nous avons essayé sans succès de vous joindre téléphoniquement ces derniers jours et avons laissé de nombreux messages pour que vous nous rappeliez, également sans succès. Nous devons vous faire savoir que, faute de connaître votre position d'ici le 30 septembre 2001, nous devons comprendre que vous vous opposez au principe du renouvellement de ce brevet.

Cette situation est très urgente et nous vous saurions gré de nous retourner, au moyen de l'enveloppe ci-jointe, avec une copie par fax si possible, la demande de renouvellement dûment signée par vos soins.

Dans l'attente de vos nouvelles et vous remerciant par avance de votre collaboration dans cette affaire, recevez, Madame, l'expression de nos sentiments distingués.

*Peter Bromley*

Dr. Peter Bromley  
President & CEO

Annexe ment.

**Gene Control S.A.****By DHL**

Mrs Anne Georgette Christiane Delachet  
Avenue Brancolar, 111/A  
06100 Nice  
France

Geneva, September 25, 2001

**Ref.: Patent IP no. MI 97 A001972 and PCT/IT98/00231 – Brevetto n° 129445**

Mrs.,

As you certainly know, the rights for the above mentioned patents have to be maintained in the United-States as well as in Canada, therefore, all the inventors, respectively the heirs of the inventors, have to give their agreement to this operation by signing the official renewal papers.

We would like to inform you that one of the founding members of Gene Control S.A. is Peter Bromley (who at that time initiated this project with Mr. Romeo Roncucci), that we are since 1998, holders for 40% of the above mentioned patents (the rest being held by the "Centre National de la Recherche italien" (CNR) and by the European Union (UE) and that, having suffered of the CNR management in this case, we have as from today taken over the management of these patents and we are in negotiation with the CNR and the UE concerning the total acquisition of the patent rights.

We have heard through the CNR, who used to manage the patent, that you had sent them back these documents unsigned. Considering the above, we kindly ask you to please sign the ad hoc form here enclosed in order to validate the renewal of the patent, as have already done all the other persons concerned.

We have tried unsuccessfully these last days to reach you by phone and have also left numerous messages for you to call us back equally without success. We have to let you know that without us knowing your position until September 30 2001, we shall understand that you are opposed to the renewal of this patent.

This situation is very urgent, therefore, would you please return the renewal request signed by yourself, using the enclosed envelope and if possible together with a fax copy.

We look forwards to hear from you and thank you in advance for your collaboration regarding the present matter.

Yours faithfully

Dr. Peter Bromley  
President & CEO

Enclosures: Ment.



(heure locale)

Numéro de bordereau	Station d'origine	Station de destination	Etat de la livraison
4530975131	Geneva - Switzerland	Nice - France	Destinataire absent lors de la livraison le: Octobre 26, 2000 11:19

**4530975131 - Rapport détaillé**

Date	Heure	Station desservant la zone	Points de contrôle
Octobre 19, 2000	17:13	Geneva - Switzerland	Envoi enlevé
Octobre 19, 2000	18:30	Geneva - Switzerland	Envoi traité à l'agence DHL d'origine
Octobre 20, 2000	11:11	Nice - France	Programmé pour livraison
Octobre 20, 2000	12:40	Nice - France	Destinataire absent lors de la livraison
Octobre 23, 2000	08:55	Nice - France	Programmé pour livraison
Octobre 23, 2000	12:34	Nice - France	Destinataire absent lors de la livraison
Octobre 24, 2000	09:25	Nice - France	Programmé pour livraison
Octobre 24, 2000	13:30	Nice - France	Destinataire absent lors de la livraison
Octobre 24, 2000	19:21	Nice - France	Destinataire absent lors de la livraison
Octobre 26, 2000	11:19	Nice - France	Destinataire absent lors de la livraison



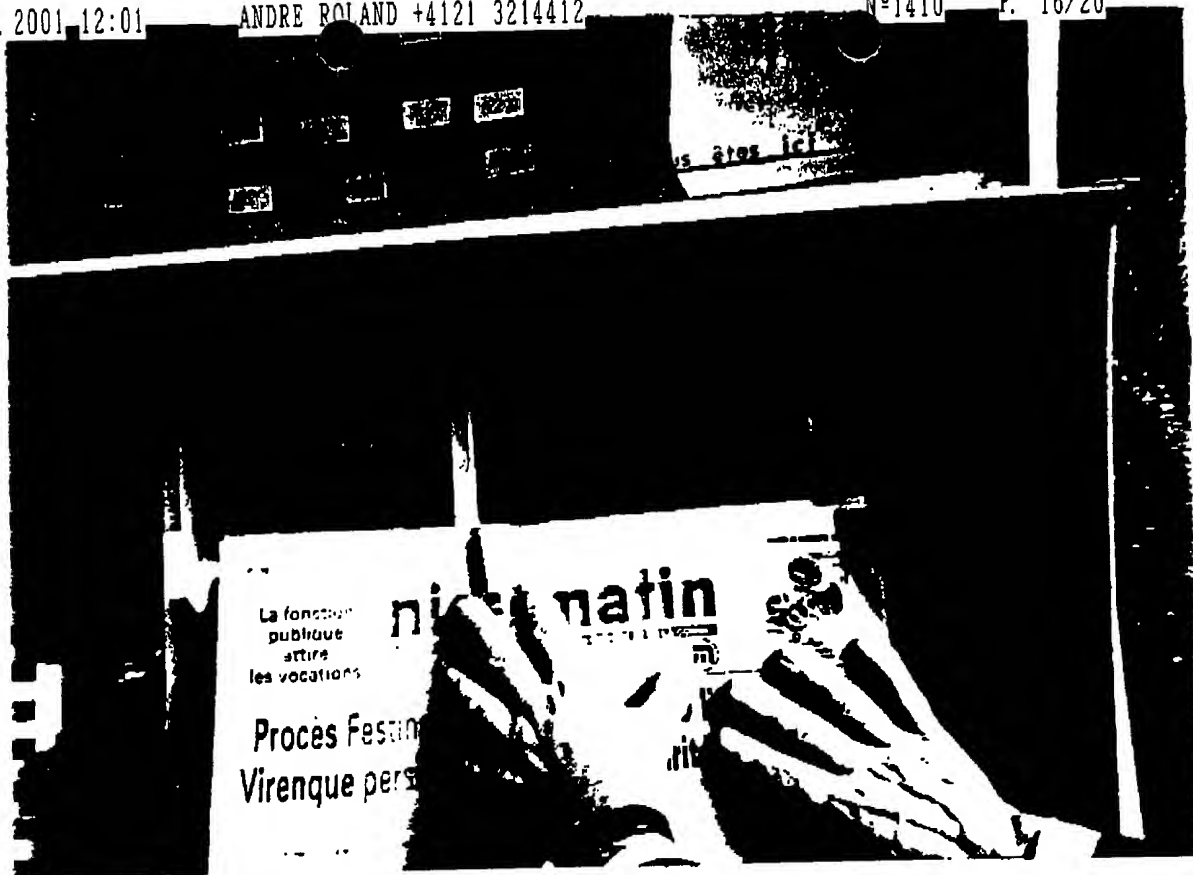
(heure locale)

Numéro de bordereau	Station d'origine	Station de destination	Etat de la livraison
<u>4530975116</u>	<u>Geneva - Switzerland</u>	<u>Nice - France</u>	Programmé pour livraison le: Octobre 27, 2000 08:30

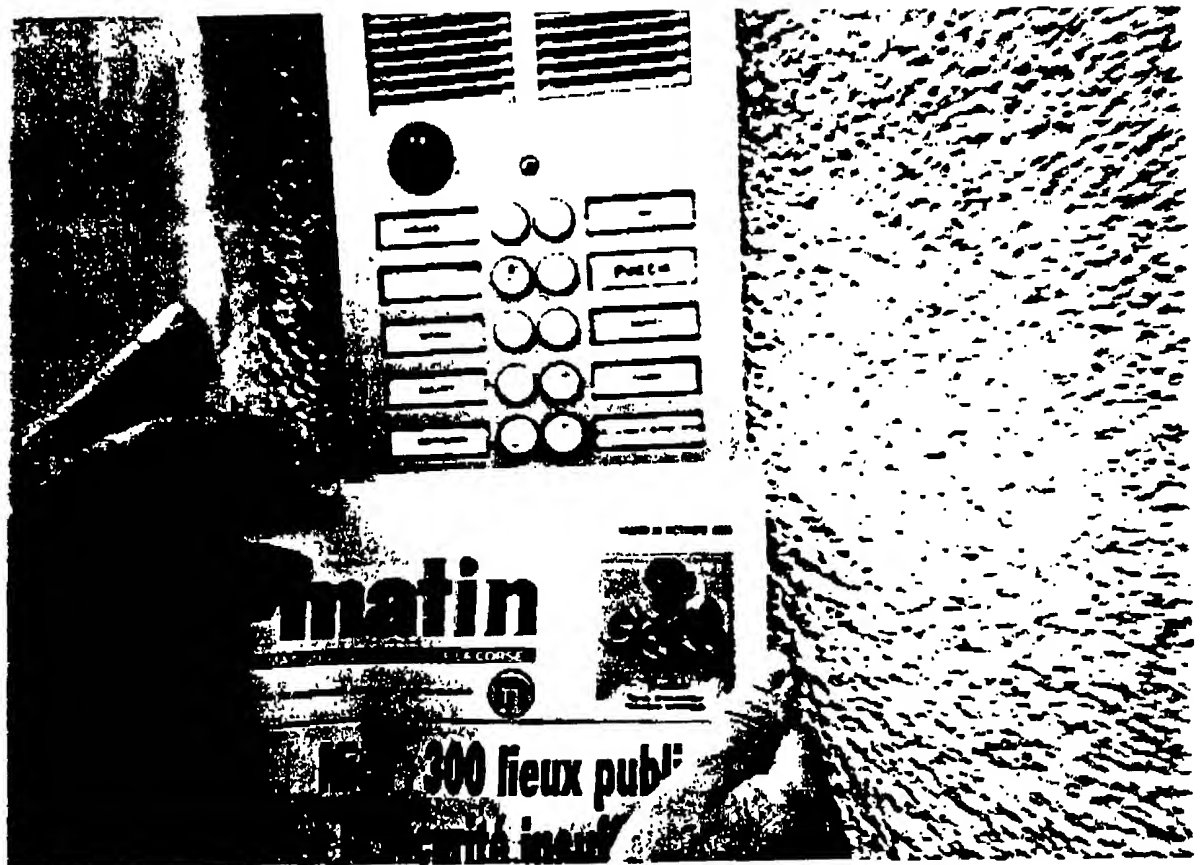
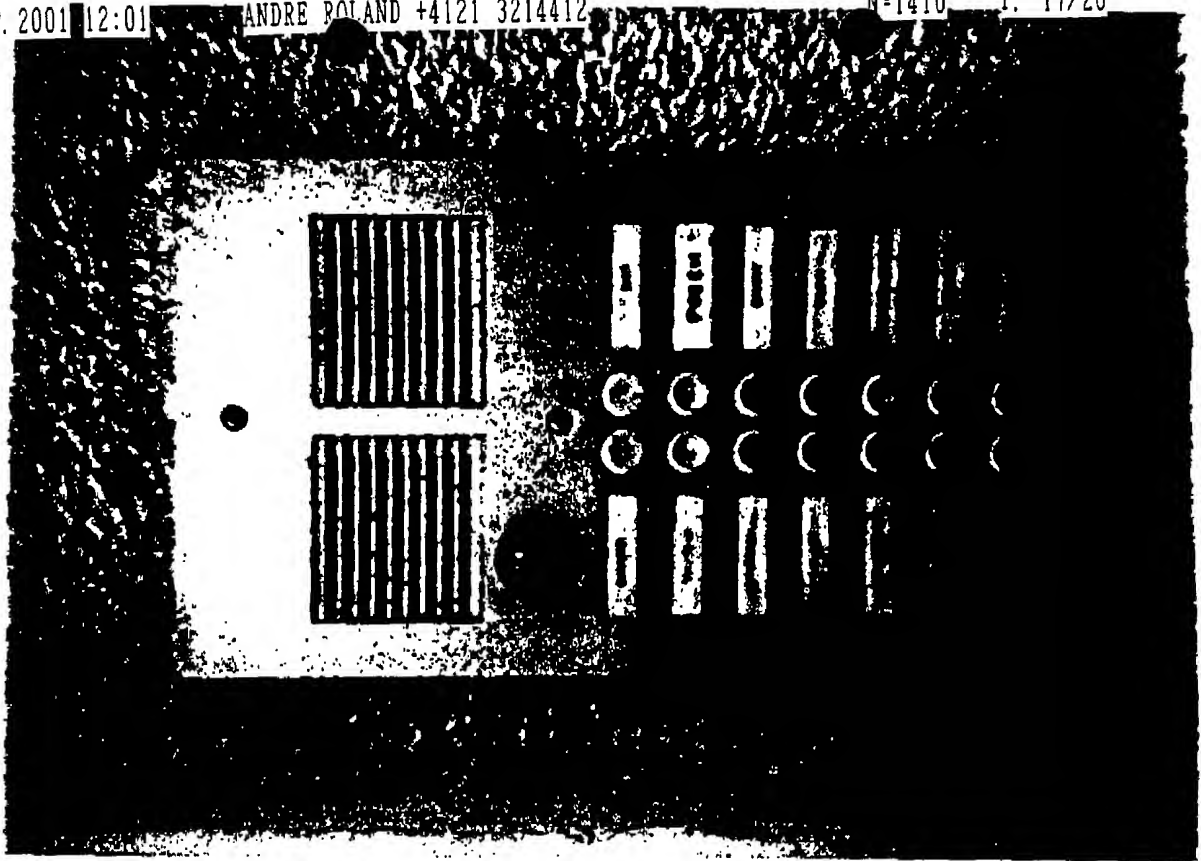
**4530975116 - Rapport détaillé**

Date	Heure	Station desservant la zone	Points de contrôle
Octobre 20, 2000	16:42	Geneva - Switzerland	Envoi enlevé
Octobre 20, 2000	18:42	Geneva - Switzerland	Envoi traité à l'agence DHL d'origine
Octobre 23, 2000	08:55	Nice - France	Programmé pour livraison
Octobre 23, 2000	12:35	Nice - France	Destinataire absent lors de la livraison
Octobre 24, 2000	09:25	Nice - France	Programmé pour livraison
Octobre 24, 2000	12:57	Nice - France	Destinataire absent lors de la livraison
Octobre 24, 2000	19:21	Nice - France	Destinataire absent lors de la livraison
Octobre 26, 2000	10:09	Nice - France	Programmé pour livraison
Octobre 26, 2000	19:00	Nice - France	Envoi en attente de livraison
Octobre 27, 2000	08:30	Nice - France	Programmé pour livraison











(heure locale)

Numéro de bordereau	Station d'origine	Station de destination	Etat de la livraison
4754533000	Geneva - Switzerland	Nice - France	Signé par : DELACHET Signature Septembre 26, 2001 12:17 ✓

**4754533000 - Rapport détaillé**

Date	Heure	Station desservant la zone	Points de contrôle
Septembre 25, 2001	15:11	Geneva - Switzerland	Envoi enlevé
Septembre 25, 2001	18:12	Geneva - Switzerland	Envoi traité à l'agence DHL d'origine
Septembre 25, 2001	19:54	Geneva - Switzerland	Envoi enlevé du centre de service DHL de Geneva - Switzerland
Septembre 25, 2001	19:56	Geneva - Switzerland	Envoi arrivé au centre de service DHL de Geneva - Switzerland
Septembre 26, 2001	05:42	Metz Hub, France - France	Envoi enlevé du centre de service DHL de Metz Hub, France - France
Septembre 26, 2001	08:57	Nice - France	Envoi arrivé au centre de service DHL
Septembre 26, 2001	09:11	Nice - France	Programmé pour livraison
Septembre 26, 2001	12:17	Nice - France	Signature